

REMARKS

Reconsideration of the above-identified patent application, as amended, is respectfully requested. Applicant has canceled all of the claims in the application with the exception of claims 2, 3, 4, 6 and 9. Thus, the basis of the objection/rejection as listed in the most recent communication from the Examiner in paragraphs 1, 2b, 2c, 3b, 6 and 9 are obviated.

In paragraph 2D of the Examiner's most recent communication, exception was taken to the term "long-lasting." As a result, the term "long" as been deleted from remaining claims.

In paragraphs 2a and 3a of the Examiner's communication, exception was taken to the term "vehicle." As a result, the term has been eliminated from the remaining claims.

In the paragraph 9 of the Examiner's communication, claims 1, 7, 13-14, and 19-20 have been rejected in view of the prior art and have been canceled herewith.

The remaining reasons for the rejection of the claims is as recited in the Examiner's paragraphs 7, 8, 10, 11 and 12.

The remaining claims have been rejected under 35 USC 103(a) in view of the declarants'/applicants' declarations in that the claimed method produced paint which was used on a public building and in doing so donated the claimed invention to the public because the paint became the property of the public building upon its application of its premises. The issue has therefore been raised by the Examiner as to whether or not the invention was offered for sale or in public use prior to the statutory bar date.

Regarding the “on sale” issue, the “on sale” bar applies when two conditions are satisfied before the critical date. “First, the product must be the subject of a commercial offer for sale . . . Second, the invention must be ready for patenting. The condition may be satisfied in at least two ways: By proof of reduction to practice before the critical date; or by proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable the person skilled in the art to practice the invention.” *Plaff v. Wells Electronics, Inc.*, 525 US 55 (1998), 67-68.

Referring to the Oltman Declaration, paragraph 10, he states that in early April 2001 and prior to April 30, 2001 he repainted unit 1601 for no charge with the new scented potpourri paint. Further, in paragraph 19, Mr. Oltman states that he painted Unit 1601 without charge as an experiment to further the perfection of his invention and that he did not receive any commercial gain from painting Unit 1601 with the new paint described in the Declaration. Further, in paragraph 23, Mr. Oltman states that he or his co-inventor did not receive any monies or other consideration relating to the claimed method or for painting using a mixture produced by the claimed method until the summer of 2005 (which was after the filing of the subject application) whereupon they painted the interior of a garage owned by a Janet Adams of Indianapolis, Indiana. Further in the Declaration are additional statements regarding the experimentation which will be discussed in relationship to the alleged public use of the invention.

In summary, the activity which took place prior to the statutory time period was all related to experimentation without any type of commercial gain. It is therefore believed that the invention was not on sale prior to the statutory time date.

Relating to the public use bar, the Examiner notes in his paragraph 6 that “further evidence of experimentation occurring during the time proceeding filing of the instant application in which the statutory bar may occur is needed to determine what experimentation was done during the statutory bar and if such experimentation was sufficient to overcome said statutory bar.” This is what the United States Court of Appeals for the Federal Circuit indicates in the case of *New Railhead Manufacturing, LLC v. Vermeer Manufacturing Company, et al.*, 298 Fed 3d 1290 (Fed. Circuit. 2002). The Court stated “What would otherwise appear to be public use is negated if the inventor was testing claimed features of his invention . . . ‘When an evaluation period is reasonably needed to determine if the invention will serve its intended purpose, the 102(b) bar does not start to accrue while such determination is being made.’ . . . An invention can exist for the purposes of the statutory bar; however, even though it may later be refined or improved . . . Once an inventor realizes that the invention as later claimed and indeed works for its intended purpose, further experimentation may constitute a barring in public use . . .” 293 F. 3^d @ 1297.

Mr. Oltman has therefore expanded his Declaration regarding the experimentation occurring after Unit 1601 was painted with paint produced from the claimed method. Paragraphs 14-24 detail the various experiments of the inventors testing the claimed features of the invention as well as perfecting the invention for commercial use.

After April 2001 and until after September 2002 (1 year prior to the effective filing date of the subject application), the co-inventors experimented on a weekly basis both during week day evenings and on weekends.

The experiments conducted (paragraph 16) were first directed to allowing painting with a sprayer. It was noted that the sprayer became clogged when Unit 1601 was painted in April 2001. By experiment, a mixture was prepared using the steps of the claimed method and allowing the mixture to sit overnight. Mr. Oltman noticed that the components had separated and that the binder used in the Arm and Hammer[®] carpet deodorizer to deliver the scent was a silica type inert material. This inert material was clogging the sprayer tip and thus another binder was required. Thus, the co-inventors directed their attention in various experiments to selecting a suitable binder that would not clog the sprayer tip.

The next series of experiments (paragraph 17) in the same period were directed to suitably combining a binder with a scent. Many binders and scents were selected; however, they would separate and become jelled. Neither alternative was acceptable to produce a mixture that could be used commercially, namely, by spray painting.

A further set of experiments (paragraph 18) were conducted during the same period directed to producing a mixture with a scent that lasted. In many cases, the scent would disappear after a few days once a wall was painted. Eventually, after September 2002, Mr. Oltman had discovered binders and scents that could be combined that would not plug the sprayer tip, would not separate nor jell, and would provide a lasting scent.

The Examiner has further noted that the evidence of secrecy agreements, when the room was leased, etc. might be of value in determining the public use. To this extent, paragraphs 20-24 of Mr. Oltman's Declaration discuss the confidentiality of the invention. More specifically, Mr. Oltman was exclusively given access to Unit 1601 and was provided a key to the unit during the painting thereof. No one had access to the

room except the employees of the owner of the building. Further, no one was granted access to the unit during painting of the unit except as otherwise detailed by the Declarations previously submitted. Even though the unit was eventually rented, the details of the claimed method were not revealed to perspective renters nor was the fact that the unit previously had a smoke smell. It would be impossible for the prospective renters to have known that the smoke smell had been eliminated by the method described.

As recited in paragraph 22 of Mr. Oltman's Declaration, even though the unit was rented during the year following April 2001, the method claimed in the subject invention was maintained as a secret. That is, the steps were not disclosed to anyone other than as detailed in the Declaration submitted in support of the subject application. Further, anyone who knew of the various steps of the method were requested to not pass on the information concerning the steps. As a result, Mr. Oltman did not feel it necessary to enter into a written secrecy agreement. Last, the nature of the method or the steps of the method could not be determined by being physically in Unit 1601.

In view of the above, it is believed that applicant's amended Declaration as submitted herewith does not show public use or on sale activity prior to the statutory bar date. Thus, it is believed that the rejection under 35 USC 103(a) as detailed in paragraph 7 of the Examiner's most recent communication should be rescinded.

The claims have been rejected under 35 USC 102(e), as detailed in paragraph 8 of the Examiner's communication as anticipated by the U.S. Patent 6,706,107 issued to Walker. The claims have further been rejected under 35 USC 103(a), as detailed in paragraph 10 of the Examiner's communication as being unpatentable over the Walker patent. Applicants' position is that the Walker reference is not available for citation.

Submitted herewith is a copy of the Walker provisional patent application Serial No. 60/282,307, filed on April 5, 2001, available on PAIR. Most importantly, there is nothing in the provisional application that discusses, suggests, or hints at the idea using a scenting agent as required by the claims remaining in the application. Information relating to scent as recited in column 5, lines 1-20 of the Walker U.S. Patent 6,706,107 was not filed until the actual utility patent application filing on February 12, 2002, long after the April 2001 date wherein Unit 1601 was painted with paint produced in accordance with Applicants' claimed mixture. It is therefore believed the rejection as detailed in paragraphs 8 and 10 of the Examiner's communication should be rescinded.

The claims have further been rejected under 35 USC 103(a) as detailed in paragraph 11 of the Examiner's communication in that the claims are allegedly unpatentable over the U.S. Patent Publication No. 2003/0232901 of Maleeny et al. in view of each of U.S. Patent Nos. 5,705,560, 6,706,107, 6,583,195, and 5,217,378.

The U.S. patent application publication of Maleeny et al. was published after the effective filing date of applicants' application. Further, the Maleeny et al. publication was based on a filing of June 17, 2002 which likewise occurred after applicants' painting of Unit 1601. It is therefore believed that the Maleeny et al. publication should not be considered and that the rejection as detailed in paragraph 11 of the Examiner's communication should be rescinded.

Last, the claims have been rejected under 35 USC 103(a) as being unpatentable over the combination of U.S. Patent 5,078,792 to Hinkle et al., French Patent Publication 2807441 to Hadded, in view of U.S. Patent 5,705,560 to Takarabe et al., U.S. Patent 6,583,195 to Sokol and U.S. Patent 5,217,378 to Donovan.

The rejection states that the references of Hinkle and Hadded disclose the scenting of paint but do not disclose the instantly claimed paint components nor the claimed mixing orders. Further, the explanation of the rejection states that Takarabe shows the instantly claimed paint components to be common paint components. Nevertheless, the mixing orders of the paint components are allegedly within the ability of the ordinary skilled artisan. No reference has been cited showing the mixing orders.

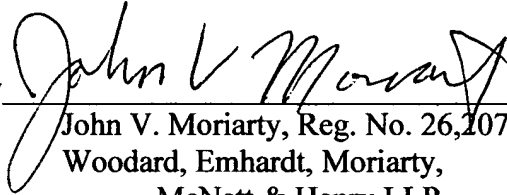
Applicants' claimed invention recites the mixing orders and it is not believed obvious to the skilled artisan. After extensive experimentation, the applicants were able to produce a perfected invention which is evidence as to the non-obviousness. For this reason, it is believed the rejection as detailed in paragraph 12 should be rescinded.

Submitted herewith is an amended Declaration of Oscar D. Sandlin which is identical to the previously submitted Declaration with the exception that paragraph 4 has been revised to define the method as claimed in claim 9 in lieu of claim 7 since claim 7 has been canceled herein.

For the above reasons, it is believed the subject application is in condition for allowance and such action by the Examiner is respectfully requested. In the event the Examiner believes that additional amendments and/or information would be helpful, then it is requested that the undersigned be contacted by telephone to expedite the case.

Respectfully submitted,

By

A handwritten signature in black ink, appearing to read "John V. Moriarty", is written over a horizontal line.

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